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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,907	12/22/2000	Takahiro Endo	1344.1052 (JDH)	6594

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EXAMINER

RETTA, YEHDEGA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/741,907	Applicant(s) ENDO ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed December 28, 2005. Applicant amended claims 1, 8, 9, 15, 21-23 and added new claim 24. Claims 1-24 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 24 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Stanbach et al. (US 6,449,657).

Regarding claim 24, Stanbach teaches inputting preference trends of an addressee, selecting an advertisement to fit the preference trends of said addressee, associating the advertisement with a card; and sending card to the addressee (see col. 9 line 55 to col. 10 line 14, col. 11 lines 10-22).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimoto et al. JP 11-242714 further in view of Stanbach, Jr. et al. (US 6,449,657).

Regarding claims 1-7, Sugimoto teaches means for sending a card attached with an optional message to a specified addressee; means for inputting a preference trends of addressee and means for inputting a preference trends of sender; means for adding advertisement selected to the card; means for selecting advertisements suitable for the preference trends of addressee; and means for selecting advertisements suitable for the preference trends of sender; means for making the card sending client select one piece of advertisement from the plurality of advertisement displayed; storing card sending history; frequency counting means; means for sending card attached with the advertisement ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3). Stanbach teaches the addressee (recipient) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile of the intended recipient is generated and advertisement matching the profile of the intended recipient is selected from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the

Art Unit: 3622

invention to generate participant's profile and to selected advertisement based on the profile of the intended recipient (preliminarily determining the addresses), as in Stanbach, in Sugimoto's greeting card sending method/system so the advertiser could provide a targeted advertisement.

Regarding claims 8-14, Sugimoto teaches means for sending card attached with optional message to specified addressee; means for inputting preference trends; means for selecting advertisement; means for presenting advertisement; selecting advertisement information suitable for the addressee; selecting advertisement information suitable for the sender; selecting and presenting plurality of advertisements; card sending client select one of the advertisement; a card sending history; changing additional information ... (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information_ (see pp. 16 lines 24-32 (par. 2), pp. 17 par. 2&3). Stanbach teaches the addressee (recipient) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile of the intended recipient is generated and advertisement matching the profile of the intended recipient is selected from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate participant's profile and to selected advertisement based on the profile of the intended recipient (preliminarily determining the addresses), as in Stanbach, in Sugimoto's greeting card sending method/system so the advertiser could provide a targeted advertisement.

Claims 15-20 are rejected as stated above in claims 8-15.

Regarding claims 21-23, Sugimoto teaches sending a card attached with an optional message to a specified addressee; input preference trends of the addressee; selecting

Art Unit: 3622

advertisement information to fit the preference trends of the addressee and adding the advertisement information; inputting preference trends of sender; selecting advertisement to fit the sender's preference trends and presenting the advertisement to sending client (see pp. 10-11, 13-14, 16-21 and fig. 10-13). Sugimoto teaches wherein the advertisement selection means selects the advertisement information from the plurality of advertisement information_ (see col. 16 lines 24-32 (par. 2) pp. 17 par. 2&3). Stanbach teaches the addressee (recipient) being preliminarily determined by the advertisement provider upon selection of the advertisement information (see col. 9 line 55 to col. 10 line 14). Stanbach teaches the demographic profile of the intended recipient is generated and advertisement matching the profile of the intended recipient is selected from a plurality of advertisements. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate participant's profile and to selected advertisement based on the profile of the intended recipient (preliminarily determining the addresses), as in Stanbach, in Sugimoto's greeting card sending method/system so the advertiser could provide a targeted advertisement.

Response to Arguments

Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Chen (US 6836792) teaches advertisements selected based on profile of e-mail recipient.

Art Unit: 3622

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RETTA YEHDEGA
PRIMARY EXAMINER

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